

**REMARKS****Summary of the Office Action**

Claims 1, 3-8 and 11-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,898,655 to Takahashi (hereinafter "Takahashi").

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of U.S. Patent No. 6,556,524 to Takeshita (hereinafter "Takeshita").

Claims 9 and 10, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form.

**Summary of the Response to the Office Action**

Applicants have amended claims 1, 8 and 11-13 to differently describe embodiments of the invention. Accordingly, claims 1-13 remain pending for consideration.

**Rejections under 35 U.S.C. §§ 102(b) and 103(a)**

Claims 1, 3-8 and 11-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Takahashi. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Takeshita. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed as follows.

Claim 1 has been newly-amended to recite a "recording medium on which information is to be recorded by an information recording apparatus, wherein at the time of manufacturing the recording medium, there are recorded in advance at least: identification information ... and recording parameter information ... (emphasis supplied)." This amendment to claim 1 is supported at least by page 15, lines 13 to 26 of the instant application's specification.

Applicants respectfully submit that the applied Takahashi reference relates to an optical

recording medium and an associated method for setting a laser beam power. Referring to Figs. 1a, 1b, and 2 of Takahashi, test areas (TEST1 to TESTn) and power setting information recording areas (PREC1 to PRECn) are shown. Based on the writing of test signals in the test areas (TEST1 to TESTn), identification (ID) information of a recording system and a predetermined optimum power setting parameter are written in the power setting information recording areas (PREC1 to PRECn). See col. 2, lines 40 to 65 of Takahashi.

Applicants respectfully submit that the test areas (TEST1 to TESTn) and power setting information recording areas (PREC1 to PRECn) in Takahashi generally correspond to a power calibration area (PCA) and a recording management area (RMA), for example, in Fig. 1 of the instant application, respectively. Applicants respectfully submit that these portions of Takahashi thus do not relate to the the instant application's lead-in area in which identification information and recording parameter information are to be recorded, as shown, for example, in Fig. 1 of the instant application. The recording medium combination recited in claim 1 relates to a lead-in area in which identification information and recording parameter information are to be recorded, as illustrated, for example, in Fig. 1 of the instant application.

An important difference between the arrangement recited in newly-amended claim 1 and the applied Takahashi reference will now be further explained in detail. In the arrangement recited in newly-amended independent claim 1 of the instant application, at the time of manufacturing the recording medium, at least identification information and recording parameter information are recorded in advance on the recording medium. As a result, when information is later recorded on the recording medium, the identification information and the recording parameter information that were previously recorded in advance are read. Based on the identification information and recording parameter information, the information to be

newly-recorded can be recorded on the recording medium in an optimum condition.

On the other hand, Applicants respectfully submit that in Takahashi, test signals are recorded in test areas (TEST1 to TESTn). Based on the writing of test signals in these test areas (TEST1 to TESTn), identification (ID) information of a recording system and a predetermined optimum power setting parameter are written in the power setting information recording areas (PREC1 to PRECn) before information is recorded in an information recording area. The recording in the test areas (TEST1 to TESTn) and the power setting information recording areas (PREC1 to PRECn) is made after the manufacturing process of recording medium, which results in a significant difference from the recording medium combination recited in newly-amended independent claim 1 of the instant application.

As discussed above, the recording medium combination recited in newly-amended independent claim 1 of the instant application and the disclosure of Takahashi differ from each other at least as follows. In the recording medium of claim 1, identification information and recording parameter information are recorded at the time of manufacturing the recording medium. On the other hand, in Takahashi, test signals and identification (ID) information of a recording system and a predetermined optimum power setting parameter are recorded after the manufacturing process of the recording medium. As a result, Applicants respectfully submit that the recording medium combination recited in newly-amended independent claim 1 is both novel and non-obvious in light of any teach or suggestion in Takahashi. Moreover, Applicants respectfully submit that the applied secondary reference of Takeshita fails to cure the deficiencies of Takahashi in this regard. In addition, each of the remaining independent claims 8 and 11-13 have been amended to include the “at the time of manufacturing of the recording medium” feature and thus similar arguments for patentability also apply to newly-amended

independent claims 8 and 11-13 as described above with regard to newly-amended independent claim 1.

Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Takahashi and Takeshita, whether taken singly or combined, do not teach or suggest each feature of independent claims 1, 8 and 11-13, as newly-amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicants respectfully assert that dependent claims 2-7 are allowable at least because of the dependence from independent claim 1, and the reasons set forth above.

The Examiner is thanked for the indication that claims 9 and 10, while objected to as including allowable subject matter, would be allowable if rewritten in independent form. However, Applicants respectfully assert that dependent claims 9 and 10 are allowable at least because of their dependence from independent claim 8, and the reasons set forth above. Accordingly, withdrawal of the objection to dependent claims 9 and 10 is respectfully requested.

### CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the timely allowance of this application. Should the Examiner feel that there are any issues outstanding after

consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

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By:



Paul A. Fournier

Reg. No. 41,023

**CUSTOMER NO. 009629**

**MORGAN, LEWIS & BOCKIUS LLP**

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Tel: 202-739-3000

Fax: 202-739-3001